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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/375,514	08/17/1999	JOHN C. REED	04040/1200990-US5	5198

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EXAMINER
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VIVLEMORE, TRACY ANN

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/375,514	REED, JOHN C.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tracy Vivlemore	1635	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 53 and 70-88 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 53 and 76-81 is/are allowed.
- 6) ☒ Claim(s) 70, 71 and 74 is/are rejected.
- 7) ☒ Claim(s) 72, 73, 75 and 82-88 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on April 25, 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Drawings***

The formal drawings were received on April 25, 2003. These drawings are acceptable.

#### ***Rejection under Non-statutory double patenting***

The rejection of claim 70 under the judicially created doctrine of non-statutory double patenting is withdrawn in view of the terminal disclaimer filed on October 15, 2003.

#### ***Claim Rejections - 35 USC § 112***

The rejection of claims 71, 73, 75 and 82-88 under 35 USC 112, second paragraph in the office action dated July 15, 2003 is withdrawn. The substitute sequence listing changing SEQ ID NOS: 20 and 22 from amino acids to nucleotides is sufficient to overcome the rejection. This substitute sequence listing does not introduce new matter as the sequence listing originally filed on March 2, 2000 shows SEQ ID NOS: 20 and 22 as containing both nucleotides and amino acids.

The rejection of claim 72 under 35 USC 112, first paragraph as lacking written description is withdrawn.

***Claim Rejections - 35 USC § 102******Response to Arguments***

The rejections of claim 70 under 35 USC 102(b) and 102(e) in the office action dated July 15, 2003 are withdrawn. The examiner had stated in the previous action that applicant's priority date of December 22, 1988 was not valid for SEQ ID NOS: 19 and 22 as the parent applications, 07/840,716 and 07/288,692, did not disclose these sequences and the earliest priority date for these sequences was August 17, 1999, the filing date of the instant application. Upon further consideration the instant application has a priority date of September 20, 1993 with regard to the disclosure of SEQ ID NOS: 19 and 22. It is noted that in the response of October 13, 2003 applicant asserts that a claim to priority to application 07/288,692, filed December 12, 1988 exists for the instant application. However, the '256 application is a continuation in part of the '692 application. The disclosure of SEQ ID NOS: 19 and 22 does not appear in the '692 application, thus priority for these aspects of the instant invention can only be given to the filing date of the application in which these sequences are first disclosed: the '256 application, filed September 20, 1993. If applicant believes there is a disclosure of SEQ ID NOS: 19 and 22 in the '692 application, it should be pointed out, with particularity, where such disclosure can be found, or evidence should be provided that these sequences were submitted with the '692 application.

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Applicant's arguments in the response of October 15, 2003 that the cited references of Capaccioli et al. do not qualify as prior art are persuasive in view of the priority date of September 20, 1993.

### ***New Rejections***

Claim 70 is rejected under 35 U.S.C. 102(b) as being anticipated by Georges et al. (WO 9213102, August 6, 1992).

1. Claim 70 is drawn to an anticodon oligomer 10-40 bases in length that is complementary to a portion of SEQ ID NO: 19. Georges et al. disclose on page 315-316, SEQ ID NO: 470, a 30 base oligomer that is complementary to 28 out of 30 of bases 2310-2339 of SEQ ID NO: 19. The specification states that anticodon oligomers need not be fully complementary; on page 12, lines 10-12, the specification teaches, "...oligonucleotides complementary or substantially complementary to the bcl-2 pre-mRNA or mRNA that inhibit cell proliferation is suitable for use in the invention." Thus, Georges et al. anticipate claim 70.

The reference of Georges et al. is a document of over 500 pages, more than 300 pages of which is the sequence listing. In the interests of reducing the costs associated with photocopying and mailing such a large document, the sequence listing not relevant to the current rejection is being left out of the copy of this reference that is being provided to the applicant. What will be mailed to the applicant is the specification, claims, drawings and the portion of the sequence listing containing the sequence used to formulate the rejection being made in this action.

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Claim 70 is rejected under 35 U.S.C. 102(e) as being anticipated by Gold et al. (US 5,475,096, December 12, 1995).

2. Claim 70 is drawn to an anticodon oligomer 10-40 bases in length that is complementary to a portion of SEQ ID NO: 19. Gold et al. disclose on column 123 SEQ ID NO: 206, a 35 base oligomer wherein bases 6-33 are partly complementary to bases 3351-3378 of SEQ ID NO: 19. The specification states that anticodon oligomers need not be fully complementary; on page 12, lines 10-12, the specification teaches, "...oligonucleotides complementary or substantially complementary to the bcl-2 pre-mRNA or mRNA that inhibit cell proliferation is suitable for use in the invention." Thus, Gold et al. anticipate claim 70.

Claims 70 and 74 are rejected under 35 U.S.C. 102(e) as being anticipated by Caceci et al. (US 5,932,697, December 12, 1995).

3. Claim 70 is drawn to an anticodon oligomer 10-40 bases in length that is complementary to a portion of SEQ ID NO: 19. Claim 74 limits claim 70 by specifying the anticodon oligomer binds to the 5' untranslated region of SEQ ID NO: 19. Caceci et al. disclose on column 17 SEQ ID NO: 10, a 33 base oligomer wherein bases 1-32 are partly complementary to bases 74-105 of SEQ ID NO: 19. As the start codon in SEQ ID NO: 19 begins at base 455, the oligomer of Caceci et al. binds to the 5' untranslated region of SEQ ID NO: 19. The specification states that anticodon oligomers need not be fully complementary; on page 12, lines 10-12, the specification teaches, "...oligonucleotides complementary or substantially complementary to the bcl-2 pre-

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mRNA or mRNA that inhibit cell proliferation is suitable for use in the invention.” Thus, Caceci et al. anticipate claims 70 and 74.

Claim 71 is rejected under 35 U.S.C. 102(b) as being anticipated by Wilcox et al. (EP 0340948, November 8, 1989).

4. Claim 71 is drawn to an anticodon oligomer 10-40 bases in length that is complementary to a portion of SEQ ID NO: 22. Wilcox et al. disclose on page 16, line 11, an 11 base oligomer that is complementary to bases 353-363 of SEQ ID NO: 22. Thus, Wilcox et al. anticipate claim 71.

Claim 71 is rejected under 35 U.S.C. 102(e) as being anticipated by Thompson et al. (US 5,750,390, May 12, 1998).

5. Claim 71 is drawn to an anticodon oligomer 10-40 bases in length that is complementary to a portion of SEQ ID NO: 22. Thompson et al. disclose a 36 mer oligomer designated as SEQ ID NO: 15 (shown on column 21) that is partially complementary to bases 560-587 of SEQ ID NO: 22. The specification states that anticodon oligomers need not be fully complementary; on page 12, lines 10-12, the specification teaches, “....oligonucleotides complementary or substantially complementary to the bcl-2 pre-mRNA or mRNA that inhibit cell proliferation is suitable for use in the invention.” Thus, Thompson et al. anticipate claim 71.

***Allowable Subject Matter***

6. Claims 53 and 76-81 are allowed.
7. Claims 72, 73, 75 and 82-88 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracy Vivlemore whose telephone number is 571-272-2914. The examiner can normally be reached on Mon-Fri 8:45-5:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader can be reached on 571-272-0760. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within



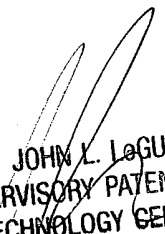
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TV  
September 28, 2004

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